

REMARKS

Applicant expresses appreciation to the Examiner for consideration of the subject patent application. This amendment is in response to the Office Action mailed April 6, 2006. Claims 1-4, 7-13, 18-21, and 24-29 were rejected. Claims 1-4, 7-21, and 24-30 remain in the application. Claims 1-29 were originally presented. Claims 5, 6, 22 and 23 have been canceled without prejudice. Claims 14-17 were previously withdrawn, but are now allowable as depending from an allowable generic claim. Claim 30 was added. Support for the claims is found in the specification and drawings. No new matter was added.

Claim Rejections - 35 U.S.C. § 103

Claims 1-4, 7, 9-12, 18-21 and 24-29 (including independent claims 1, 18, 25 and 29) were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sato (JP 08156351) in view of Miyawaki (U.S. 2002/0047885). Applicant respectfully traverses this rejection.

Before discussing the rejection, it is thought proper to briefly state what is required to sustain such a rejection. The issue under § 103 is whether the PTO has stated a case of *prima facie* obviousness. "The PTO has the burden under § 103 to establish a *prima facie* case of obviousness." In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). To satisfy this burden, the PTO must meet the criteria set out in M.P.E.P. § 706.02(j):

... three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Moreover, the obviousness analysis must comply with the statutory scheme as explained by the Supreme Court in Graham v. John Deere Co., 383 U.S. 1, 17 (1966), namely, consideration must be given to: (1) the scope and content of the prior art, (2) the differences between the prior art and the claimed invention, (3) the level of ordinary skill in the pertinent art, and (4) additional evidence, which may serve as indicia of non-obviousness.

With the above background in mind, the Applicant contends that the Office Action has failed to meet the burden of establishing a *prima facie* case of obviousness, and the obviousness-type rejections were based on hindsight. Specifically, the Office Action has failed to show that the cited references provide sufficient teachings or the motivation for the asserted combination in order to arrive at Applicant's invention.

Sato teaches away from combination with Miyawaki. Specifically, Sato teaches a platen with an elongated symmetrical hexagonal hole oriented with a point of the hexagon on a line parallel to the conveyance of the recording medium. Sato teaches that the symmetrical hexagon prevents the corner of a sheet from entering a hole, thereby resulting in poor sheet conveyance. (See FIGs. 2, 3, 5, and 6, and paragraphs 19-23 of the Sato reference.)

In contrast, Miyawaki teaches a plurality of rectangular openings with one long side of the rectangle located along the straight edge of the leading end of the recording medium. Moreover, Miyawaki teaches that this configuration minimizes fluctuation of absorbing power of the vacuum until the leading end of the recording medium covers the opening completely, "as compared with the case where the opening is circular." (See page 3, paragraph 45 of the Miyawaki reference). Clearly, these two references teach opposite configurations, each addressing a different problem, which cannot be resolved by simply combining the teachings.

Furthermore, combining Sato with Miyawaki destroys the function of both Sato and Miyawaki. Sato teaches that the purpose of elongated hexagonal holes is to prevent the corner of a sheet from entering a hole resulting in poor sheet conveyance. In contrast, Miyawaki teaches the purpose of the rectangular shape of the opening in Miyawaki is to absorb the leading edge of the sheet and lessen the fluctuation of absorbing power, as compared to a circular opening. The elongated symmetrical hexagonal opening of Sato, which is oriented with a point of the hexagon on a line parallel to the conveyance of the recording medium, provides the very opportunity for fluctuation of absorbing power that occurs with a circular opening, and which Miyawaki was attempting to avoid. Additionally, the straight side of the rectangular opening taught by Miyawaki provides the very opportunity for a corner of a sheet to enter a hole and interfere with sheet conveyance, which Sato was attempting to avoid. Clearly, combination of Sato with Miyawaki would make the corner saving function of Sato and the absorbing power stabilization

of Miyawaki inoperable. Thus, the two references teach away from each other and do not provide adequate motivation to combine the references.

Moreover, it is unclear to Applicant how to combine the Sato and Miyawaki references or what structure would result. Specifically, it is unclear to Applicant how to combine the elongated hexagonal hole of Sato, which is oriented with a point of the hexagon parallel to the conveyance of the recording medium, with the rectangular opening of Miyawaki that provides a straight side located along the straight edge of the leading end of the recording medium.

While Applicant cannot conceive of the geometry suggested by the combination of the Sato and Miyawaki references, clearly such a combination would not form a channel in the contact surface extending a length of the channel and having a varying cross-sectional area varying a depth of the channel along a portion of the channel, as claimed by the present invention. Because the teachings of Sato and Miyawaki oppose each other, the only way to combine the two references is to impermissibly pick and choose the desired elements based on the hindsight roadmap provided by the present application. Therefore, the Office Action has employed impermissible hindsight in rejecting the present application.

Accordingly, Applicant respectfully asserts that the contents of these references do not support the Office Action's proposed combination. Thus, the Office Action has not established a case of *prima facie* obviousness because the motivation for combination does not arise from the references themselves, and the Applicant respectfully requests withdrawal of these rejections.

Claims 1, 12 and 13 (including independent claim 1) were rejected under 35 U.S.C. § 103 as being unpatentable over Madsen et al (US Patent No. 6,209,857) in view of Sato. Applicant respectfully traverses this rejection.

Applicant again contends that the Office Action has failed to meet the burden of establishing a *prima facie* case of obviousness, and the obviousness-type rejections were based on hindsight. Specifically, the Office Action has failed to show that the cited references provide sufficient teachings or the motivation for the asserted combination in order to arrive at Applicant's invention.

Madsen teaches away from combination with Miyawaki. Specifically, Madsen teaches a platen with substantially symmetric pattern of vacuum channels. (See FIGs. 1b-d, 2b, 3b, 4, and

col. 4 lines 25-28). Madsen also teaches a sleeve inside the platen that can partially cover the vacuum channels, thereby resulting in a lower vacuum force, or vacuum depletion zones for associated platen surface channels (See FIGs. 1a, 1d, 2a, 3a, 4, and col. 5 lines 41-62 of the Madsen reference.)

In contrast, Miyawaki teaches a plurality of rectangular openings with one long side of the rectangle located along the straight edge of the leading end of the recording medium that minimizes fluctuation of absorbing power of the vacuum resulting in an extremely efficient absorbing action that can absorb even curled recording medium to the platen surface. (See page 3, paragraph 45, page 4 paragraph 61, and page 5 paragraphs 62-63 of the Miyawaki reference). Clearly, these two references teach different configurations that address different problems, which cannot be resolved by simply combining the teachings.

Furthermore, combining Madsen with Miyawaki destroys the function of Miyawaki. Madsen teaches that the purpose of the sleeve is to create vacuum depletion zones for associated vacuum channels. In contrast, Miyawaki teaches the purpose of the rectangular shape of the opening in Miyawaki is to lessen the fluctuation of absorbing power. Madsen provides the very opportunity for fluctuation of absorbing power that Miyawaki was attempting to avoid. Clearly, combination of Madsen with Miyawaki would make the absorbing power stabilization of Miyawaki inoperable. Thus, the two references teach away from each other and do not provide adequate motivation to combine the references.

Because the teachings of Madsen and Miyawaki oppose each other, the only way to combine the two references is to impermissibly pick and choose the desired elements based on the hindsight roadmap provided by the present application. Therefore, the Office Action has employed impermissible hindsight in rejecting the present application.

Accordingly, Applicant respectfully asserts that the contents of these references do not support the Office Action's proposed combination. Thus, the Office Action has not established a case of *prima facie* obviousness because the motivation for combination does not arise from the references themselves, and the Applicant respectfully requests withdrawal of these rejections.

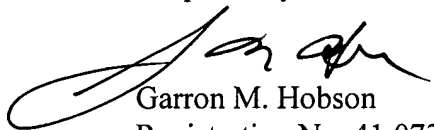
CONCLUSION

In light of the above, Applicant respectfully submits that pending claims 1-4, 7-13, 18-21, and 24-30 are now in condition for allowance. Therefore, Applicant requests that the rejections and objections be withdrawn, and that the claims be allowed and passed to issue. If any impediment to the allowance of these claims remains after entry of this Amendment, the Examiner is strongly encouraged to call Robert D. Wasson at (360) 212-2338 so that such matters may be resolved as expeditiously as possible.

The Commissioner is hereby authorized to charge any additional fee or to credit any overpayment in connection with this Amendment to Deposit Account No. 08-2025.

DATED this 29 day of June, 2006.

Respectfully submitted,



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